



PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q48708

Shinichi OSHIMA

Appln. No.: 08/988,181

Group Art Unit: 3711

Confirmation No.: 7161

Examiner: Raeann Gorden

Filed: December 10, 1997

For: GOLF BALL SELECTION DEVICE

SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

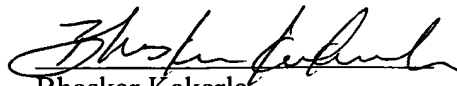
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. A check for the statutory fee of \$500.00 is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,

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Bhaskar Kakarla
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WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: July 20, 2006



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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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I. REAL PARTY IN INTEREST

The real party in interest is BRIDGESTONE SPORTS CO., LTD., the assignee of the present application. The assignment was recorded on November 9, 1994 at Reel No. 007198, Frame No. 0820 in parent application 08/338,081, now U.S. Patent No. 5,713,803.

II. RELATED APPEALS AND INTERFERENCES

This application was the subject of prior Appeal No. 2002-1912, decided on March 19, 2003. In the prior appeal, the Board decided certain issues that again are the subject of this appeal. Namely, in the prior appeal, the Board indicated that “a functional relationship clearly exists between the printed matter ..., and the substrate (the golf ball package).” Page 7 of Appeal No. 2002-1912. Accordingly, Appeal No., 2002-1912 would be directly affected by the outcome of the present appeal and, conversely, Appeal No. 2002-1912 should have a bearing on the Board’s decision in the present appeal.

Appellant, Appellant’s legal representatives, and the assignee in this application are not aware of any other pending appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board’s decision in the instant appeal.

III. STATUS OF CLAIMS

Claims 12-43 are all of the claims currently pending in the present application, and currently each of these claims stand rejected by the Examiner in the Final Office Action (Paper No. 20050916) dated September 21, 2005, which is the subject of this appeal.

IV. STATUS OF AMENDMENTS

There are no outstanding, non-entered amendments of the claims.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention is related to a package for golf balls. As was common practice in the art, golf balls were marked with an indication of hardness (e.g., PGA compression). (Specification at page 1, lines 15-19) However, such information does not provide the golfer with sufficient information to inform him of the characteristics of the golf ball, and thus the golfer is not able to select the ball best suited for his game. (Specification at page 1, line 24 to page 2, line 9). In fact, each golf ball cannot be characterized by a single function or mark. Instead, the performance and characteristics of a golf ball is defined by a number and combination of various factors.

Accordingly, the present invention provides a novel way of informing the golfer of the type of golf ball enclosed within a certain package. The invention takes into account various combinations of factors, performance characteristics, etc. that are important to a golfer in selecting the proper golf ball that is best suited to his game/style of golf.

A package (1, Fig. 1) consistent with the present invention as set forth in independent claim 12 is designed to receive golf balls (Specification at page 4, lines 10-11) and comprises a box body (2, Fig. 1), a cover (3, Fig. 1) fitted over said box body (2), and a generally rectangular indication section (4, Fig. 1). The indication section (4) is formed on the package (1) for indicating a plurality of performance characteristics (Groups A-E, Fig. 2) of the golf ball. The indicating section includes two or more sub-sections (7, Fig. 2), each of the sub-sections (7) comprising an icon and a first set of descriptive information (8, Fig. 2) to identify and specify a performance characteristic (Groups A-E) of the golf ball.

The sub-sections (7) in one group or row are provided with marks (8) belonging to the same function or performance characteristic, but each indicates different functional species. One of the marks is selected for each group or row in accordance with the performance of the golf ball. (Specification at page 8, line 20, to page 9, line 1.)

For example, the first row or group (A) includes six sub-sections (7) to which are attached marks (8) belonging to the golf ball structure and which indicate whether the ball is a thread wound ball or a two- or three-piece ball, whether the wound ball has a liquid or solid center, or has a balata cover or a Surlyn cover, whether the cover is a double cover, and whether the ball is a soft type or a spin type. The other rows provide the golfer with even yet more information about the characteristics of the ball, so that a more intelligent decision can be made when purchasing the balls. (Specification at page 9, lines 2-11.)

Another package (1, Fig. 1) consistent with the present invention as set forth in independent claim 31 is designed to receive golf balls (Specification at page 4, lines 10-11) and comprises a box body (2, Fig. 1), a cover (3, Fig. 1) fitted over said box body (2), and a generally rectangular indication section (4, Fig. 1). The indication section (4) comprises a first sub-section (7, Fig. 2) comprising a first icon and a first set of descriptive information (8, Fig. 2) representative of a first performance characteristic of the golf ball (e.g., Group A, Fig. 2); and a second sub-section (7, Fig. 2) comprising a second icon and a second set of descriptive information (8, Fig. 2) representative of a second performance characteristic of the golf ball (e.g., Group B, Fig. 2).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 12-43 are unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Anderson *et al.* (US 1,676,975) [“Anderson”].

VII. ARGUMENT

Rejection of Claims 12-43:

The Examiner has rejected claims 12-43 under 35 U.S.C. § 103(a) as being unpatentable over Anderson et al. (US 1,676,975) ["Anderson"]. For at least the following reasons, Appellant respectfully traverses the rejection.

Claim 12 recites a package for receiving a golf ball that comprises "a generally rectangular indication section formed on said package for indicating a plurality of performance characteristics of the golf ball, said section including two or more sub-sections, each of said sub-sections comprising an icon and a first set of descriptive information to identify and specify a performance characteristic of the golf ball."

Claim 31 recites a package for receiving a golf ball that comprises "a generally rectangular indication section formed on said package for indicating characteristics of the golf ball, said section comprising: a first sub-section comprising a first icon and a first set of descriptive information representative of a first performance characteristic of the golf ball; and a second sub-section comprising a second icon and a second set of descriptive information representative of a second performance characteristic of the golf ball."

In addition, claim 12 recites "a generally rectangular section," which includes "two or more sub-sections" and claim 31 recites "a generally rectangular section" that comprises "first sub-section" and "a second sub-section." The recited language covers the structural elements of the respective packages. That is, each package comprises a box body, a cover fitted over the box body, and a generally rectangular indication section with at least two sub-sections.

Anderson merely discloses a golf ball box with a flap that can be used for advertising or to explain the novelty of the box (page 1, lines 53-55). The novelty of the box is that the flap has a cutout that can be used as the hole when practicing putting (Figs. 1-3).

Therefore, the box disclosed by Anderson does not include the claimed indication section that includes two or more sub-sections as set forth in claim 12 and the claimed indication section that comprises a first sub-section and a second sub-section as set forth in claim 31.

When obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 55 USPQ2d 1313, 1316-1317. Here, there is no disclosure or suggestion in Anderson to modify its box to include an indication section with at least two sub-sections. Therefore, Appellant respectfully submits that the Examiner has failed to make a *prima face* case of obviousness for claims 12 and 31.

In addition, there is no disclosure or suggestion in Anderson that the box has features similar to the claimed indication section including two or more sub-sections for indicating performance characteristics of the golf ball as set forth in independent claim 12 or the claimed indicating section comprising a first sub-section and a second sub-section for indicating performance characteristics of the golf ball as set forth in claim 31.

In fact, the Examiner does not even contend that the claimed indication sections—with the performance characteristics as respectively set forth in claims 12 and 31—are present in the cited art. The Examiner merely contends that indicia on a box is not patentable because it is not functionally related to the substrate (box). Office Action (Paper No. 20050404) at page 2.

Appellant submits that the Examiner's position is entirely inappropriate because the issue of whether the respective claimed indicating sections with the performance characteristics should be given patentable weight has already been decided in this application by the Board of Patent Appeals and Interferences. This Board has held the following:

In the present case, a **functional relationship clearly exists between the printed matter** (the icons and sets of descriptive information relating to performance characteristics of the golf ball) **and the substrate (the golf ball package)**. Thus, the **printed matter limitations** in the appealed claims **must be evaluated** in terms of their patentable weight in assessing the obviousness of the claimed invention.

Ex parte Shinichi Oshima, Appeal No. 2002-1912 at page 7 (Bold added for emphasis).

Here, Appellant submits that the Examiner is clearly ignoring the holding of this Board in not considering the printed matter limitations in the claims.

In response to Appellants arguments in the filing of July 7, 2005, that this Board has already held that a functional relationship exists and, therefore, the printed matter must be considered, the Examiner merely contended that "[t]he indicia does not further the substrate (box)." Final Office Action (Paper No. 20050916) at page 3.

The Examiner provides no further comments on the record explaining why the holding of this Board is being ignored.

However, it is clear from the rejections that the Examiner is under the mistaken assumption that *In re Miller*, 418 F.2d 1392 (CCPA 1969), stands for the proposition that the printed matter must convey information about the substrate. This interpretation was rejected by the court in *In re Gulack*, 703 F.2d 1381 (Fed Cir. 1983).

In *Gulack*, the court held that “conveying information about substrate -- is not required.” *Id.* at 1386. The court goes on to state that “the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.” *Id.*

In the present application, this Board in the prior Appeal (*Ex parte Shinichi Oshima*, Appeal No. 2002-1912) discusses the decision in *Gulack* before holding that a functional relationship between the printer matter and the golf ball package clearly exists. *Ex parte Shinichi Oshima* at page 7. The Board then provides the specific directive that the “printed matter limitations in the appealed claims must be evaluated....”

Although the reasoning behind this Board’s decision was not fully set forth in *Ex parte Shinichi Oshima*, Appellant submits that a functional relationship clearly exists between the printed matter and the golf ball package since either by itself cannot provide the patentable advantages of easily picking a golf ball that is best suited to the golfer. That is, a golf ball package without the claimed indication of performance characteristics would not allow a golfer to easily pick a golf ball best suited for him or her, and providing printed matter of performance characteristics would not be beneficial without a link, such as a golf ball package, to the golf ball.

Accordingly, Appellant respectfully requests that this Board maintain its position that printed matter related to the performance characteristics of golf balls is functionally related to a golf ball package that includes the printed matter, and that the printed matter language in the claims must be evaluated when assessing the patentability of the claims.

Therefore, because the Examiner failed to consider the claimed performance characteristics of the golf ball as respectively set forth in claims 12 and 31, Appellant submits that the Examiner has failed to make a *prima face* case of obviousness for claims 12 and 31.

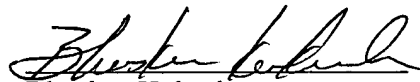
Appellant submits that the remaining claims are patentable at least by virtue of their respective dependencies

Conclusion:

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CLAIMS APPENDIX

CLAIMS 12-43 ON APPEAL:

12. A package for receiving a golf ball, said package comprising:
a box body;
a cover fitted over said box body; and
a generally rectangular indication section formed on said package for indicating a plurality of performance characteristics of the golf ball, said section including two or more sub-sections, each of said sub-sections comprising an icon and a first set of descriptive information to identify and specify a performance characteristic of the golf ball.
13. The package as defined by claim 12, wherein a first performance characteristic relates to the feel of the golf ball when struck by a first type of golf club, and a second performance characteristic relates to the spin rate of the golf ball when struck by a second type of golf club.
14. The package as defined by claim 13, wherein said first set of descriptive information identifies one of said first and second performance characteristics.
15. The package as defined by claim 14, wherein said icon includes a golf ball and golf club depicting and identifying at least one of said first and second performance characteristics.
16. The package as defined by claim 14, wherein said icon includes at least a golf ball depicting and identifying at least one of said first and second performance characteristics.

17. The package as defined by claim 14, wherein said icon includes a golf ball graphically depicting the spin of a golf ball.

18. The package as defined by claim 14, wherein said icon includes a golf ball and arrows arranged on a periphery of the golf ball for graphically depicting the spin of a golf ball.

19. The package as defined by claim 14, wherein each of said sub-sections further comprises a second set of descriptive information for indicating relative differences of said performance characteristic.

20. The package as defined by claim 13, wherein said first type of golf club is a putter.

21. The package as defined by claim 13, wherein said second type of golf club is an iron type of golf club.

22. The package as defined by claim 13, wherein said first type of golf club is a putter, and said second type of golf club is an iron type of golf club.

23. A package for receiving a golf ball as defined by claim 12, wherein said performance characteristics comprises at least two of ball structure, recommended head speed, feel, spin rate, green targeting, and trajectory.

24. A package for receiving a golf ball as defined by claim 23, wherein said performance characteristics comprises at least four of ball structure, recommended head speed, feel, spin rate, green targeting, and trajectory.

25. A package for receiving a golf ball as defined by claim 23, wherein said performance characteristic recommended head speed is depicted by said first set of descriptive information and said icon representing a recommended range of head speeds to strike the golf ball with a golf ball club.

26. A package for receiving a golf ball as defined by claim 23, wherein said performance characteristic green targeting is depicted by said first set of descriptive information and said icon representing whether the green is targeted by spin or height.

27. A package for receiving a golf ball as defined by claim 23, wherein said performance characteristic trajectory is depicted by said first set of descriptive information and said icon representing degrees of trajectory when struck by a golf ball club.

28. A package for receiving a golf ball as defined by claim 27, wherein said degrees of trajectory comprise high trajectory, intermediate trajectory, and low trajectory when the golf ball is struck by a golf ball club driver.

29. A package for receiving a golf ball as defined by claim 23, wherein said performance characteristic ball structure is depicted by said first set of descriptive information and said icon representing at least one of whether the golf ball is thread wound or a two-piece golf ball, whether the thread wound ball has a liquid or solid center, the type of cover, whether the cover is a double cover, and whether the two-piece ball is a soft type or spin type.

30. A package for receiving a golf ball as defined by claim 23, wherein at least one of said first set of descriptive information and said icon comprises a color-encoded identification mark.

31. A package for receiving a golf ball, said package comprising:

- a box body;
- a cover fitted over said box body; and
- a generally rectangular indication section formed on said package for indicating characteristics of the golf ball, said section comprising: a first sub-section comprising a first icon and a first set of descriptive information representative of a first performance characteristic of the golf ball; and a second sub-section comprising a second icon and a second set of descriptive information representative of a second performance characteristic of the golf ball.

32. The package as defined by claim 31, wherein said first performance characteristic relates to the feel of the golf ball when struck by a first type of golf club, and said second performance characteristic relates to the spin rate of the golf ball when struck by a second type of golf club.

33. The package as defined by claim 32, wherein said first set of descriptive information identifies feel as the first performance characteristic of the golf ball; and said second set of descriptive information identifies spin rate as the second performance characteristic of the golf ball.

34. The package as defined by claim 32, wherein said first set of descriptive information identifies feel as the first performance characteristic of the golf ball.

35. The package as defined by claim 32, wherein said second set of descriptive information identifies spin rate as the second performance characteristic of the golf ball.

36. The package as defined by claim 33, wherein said first and second icons depict at least one of a golf ball and a golf club for identifying said first and second performance characteristics of the golf ball.

37. The package as defined by claim 33, wherein said first icon includes a golf ball and a golf club depicting and identifying the feel of the golf ball.

38. The package as defined by claim 33, wherein said second icon includes a golf ball depicting the spin of the golf ball.

39. The package as defined by claim 33, wherein said second icon includes a golf ball and arrows arranged on a periphery of the golf ball for graphically depicting the spin of a golf ball.

40. The package as defined by claim 33, wherein said first set of descriptive information further comprises information for indicating the amount of feel of the golf ball.

41. The package as defined by claim 33, wherein said first set of descriptive information further comprises information for indicating the amount of feel of the golf ball in different relative degrees of softness.

42. The package as defined by claim 33, wherein said second set of descriptive information further comprises information for indicating the amount of spin of the golf ball when struck by an iron type golf club.

43. The package as defined by claim 33, wherein said second set of descriptive information further comprises information for indicating different relative amounts of spin of the golf ball when struck by an iron type golf club.

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U.S. Serial No. 08/988,181

Attorney Docket No.: Q48708

EVIDENCE APPENDIX:

None.

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RELATED PROCEEDINGS APPENDIX

Ex parte SHINICHI OSHIMA
Appeal No. 2002-1912
Application No. 08/988,181

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.



Paper No. 26

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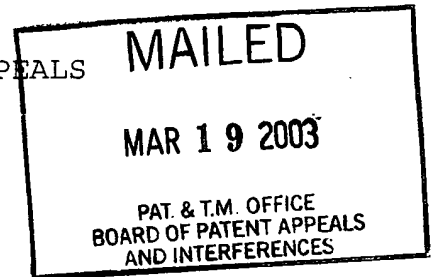
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHINICHI OSHIMA

Appeal No. 2002-1912
Application No. 08/988,181

ON BRIEF



Before FRANKFORT, STAAB and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Shinichi Oshima appeals from the final rejection (Paper No. 16) of claims 12 through 43, all of the claims pending in the application.

The record (see page 1 in the main brief, Paper No. 21) indicates that this appeal is related to a parallel appeal in Application No. 09/060,960 (Appeal No. 2002-2175).

Appeal No. 2002-1912
Serial No. 08/988,181

THE INVENTION

The invention relates to a golf ball package which is defined in representative claims 12 and 31 as follows:

12. A package for receiving a golf ball, said package comprising:

a box body;

a cover fitted over said box body; and

a generally rectangular indication section formed on said package for indicating a plurality of performance characteristics of the golf ball, said section including two or more sub-sections, each of said sub-sections comprising an icon and a first set of descriptive information to identify and specify a performance characteristic of the golf ball.

31. A package for receiving a golf ball, said package comprising:

a box body;

a cover fitted over said box body; and

a generally rectangular indication section formed on said package for indicating characteristics of the golf ball, said section comprising: a first sub-section comprising a first icon and a first set of descriptive information representative of a first performance characteristic of the golf ball; and a second sub-section comprising a second icon and a second set of descriptive information representative of a second performance characteristic of the golf ball.

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THE PRIOR ART

The items relied on by the examiner to support the final rejection are:

Connell	1,406,541	Feb. 14, 1922
Taylor	4,921,255	May 1, 1990

THE REJECTION

Claims 12 through 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Connell in view of Taylor.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 21 and 23) and to the examiner's answer (Paper No. 22) for the respective positions of the appellant and the examiner regarding the merits of this rejection.

DISCUSSION

Connell, the examiner's primary reference, discloses "a label adapted or suited for containers holding any of different types of articles" (page 1, lines 77 through 79), and more specifically "a label suitable for cartons or boxes in which may be packed any of a variety of styles or shapes of smoking pipes, the label being adapted for designating the characteristics of a particular style of pipe or pipes contained in any given box or

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carton" (page 1, lines 11 through 17). Figure 1 shows the label as comprising a label body 10 bearing (1) pictorial representations 11 of various styles of pipes made and marketed by the manufacturer, (2) indicia such as a star 13 within the representation of the particular style of pipe packaged in the carton, (3) a space 14 with a descriptive representation 15, e.g., the word "Poker," and the star indicia 16 of the packaged pipes, (4) a space 17 with the word "Quantity" and the number of pipes, e.g., 100, in the carton, (5) spaces 20 and 21 with a trade number and trade name representative of the physical characteristics of the packaged pipes, (6) a central space 22 with the trade mark 23 of the manufacturer on a background color-coded to denote the price of the packaged pipes, and (7) a space 24 with the name of the manufacturer on a like color-coded background. Connell teaches that this label serves to quickly and accurately convey the identity and characteristics of the articles packaged in the box or carton (see Connell at page 1, lines 8 through 94).

As conceded by the examiner (see page 3 in the answer), Connell does not respond to any of the limitations in independent claims 12 and 31 tying the claimed package to a golf ball.

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Taylor discloses golf balls having different dimple patterns which afford different in-flight trajectories, e.g, the low trajectories favored by most amateurs and the high trajectories desired by professionals and accomplished amateurs.

In proposing to combine Connell and Taylor to reject claims 12 and 31 (see pages 3 through 5 in the answer), the examiner submits that

[a]lthough Connell discloses cigar [sic, smoking pipe] information on the box a difference in what is attributed to printed matter does not provide a basis on which patentability may be predicated. . . . Golf balls with different playing characteristics, as disclosed by Taylor, are usually sold in boxes having a cover. It would have been obvious for one skilled in the art to label a box with pictorial illustrations and descriptive text of each ball since such is a conventional technique for informing the golfer of the different golf balls [answer, page 3].

The threshold issue with respect to this rejection is whether Connell is non-analogous art as urged by the appellant (see page 2 in the reply brief). In an obviousness determination under § 103(a), art which is non-analogous is too remote to be treated as prior art. In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). There are two criteria for determining whether a reference is analogous art: (1) whether the reference is from the field of the inventor's endeavor,

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regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether it is reasonably pertinent to the particular problem with which the inventor was involved. Id.

The specification in the instant application indicates that the appellant's field of endeavor is labeled packages for golf instruments (see page 1) and that the particular problem facing the appellant was to label such packages so as to allow a golfer to choose an instrument matching his or her skill and ability (see page 3). Even if the Connell reference does not fall within this field of endeavor, it certainly is reasonably pertinent to this problem. Hence, Connell constitutes analogous art which was properly considered by the examiner in evaluating the obviousness of the subject matter recited in the appealed claims.

Next is the issue of the examiner's dismissal of the so-called printed matter limitations in the appealed claims as not providing a basis on which patentability may be predicated. In independent claims 12 and 31, these limitations pertain to the icons and sets of descriptive information relating to performance characteristics of the packaged golf ball.

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Differences between an invention and the prior art cannot be ignored merely because those differences reside in the content of printed matter. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it is not entitled to patentable weight. What is required is the existence of differences between the claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. Id.

In the present case, a functional relationship clearly exists between the printed matter (the icons and sets of descriptive information relating to performance characteristics of the golf ball) and the substrate (the golf ball package). Thus, the printed matter limitations in the appealed claims must be evaluated in terms of their patentable weight in assessing the obviousness of the claimed invention.

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As for the teachings of the applied prior art, Connell's disclosure of a label designed to quickly and accurately convey the identity and characteristics of articles packaged in a box or carton would have furnished the artisan with ample suggestion or motivation to apply such a label to a package containing a golf ball of the sort disclosed by Taylor for the same reasons. There is nothing in the disclosures of these references, however, which would suggested providing the label with plural subsections respectively comprising an icon and a set of descriptive information relating to a performance characteristic of the ball as required by independent claims 12 and 31. In this regard, none of the packaged article characteristics depicted by the Connell label can reasonably be interpreted as a "performance" characteristic.

Thus, the combined teachings of Connell and Taylor do not justify a conclusion that the differences between the subject matter recited in independent claims 12 and 31 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 12 and 31, and

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dependent claims 13 through 30 and 32 through 43, as being obvious over Connell in view of Taylor.

SUMMARY


The decision of the examiner to reject claims 12 through 43 is reversed.

REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

Lawrence J. Staab
LAWRENCE J. STAAB
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES


JOHN P. McQUADE
Administrative Patent Judge

JPM/dal

Appeal No. 2002-1912
Serial No. 08/988,181

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§ 1.136(b) for extensions of time for seeking rehearing in a patent application and § 1.550(c) for extensions of time for seeking rehearing in a reexamination proceeding.

The term "rehearing" is used in 37 CFR 1.197(b) for consistency with the language of 35 U.S.C. 6(b). It should not be interpreted as meaning that an appellant is entitled to an oral hearing on the request for rehearing, but only to a rehearing on the written record. It is not the normal practice of the Board to grant rehearings in the sense of another oral hearing. *Ex parte Argoudelis*, 157 USPQ 437, 441 (Bd. App. 1967), *rev'd. on other grounds*, 434 F.2d 1390, 168 USPQ 99 (CCPA 1970).

37 CFR 1.197(b) provides that any request for rehearing must specifically state the points believed to have been misapprehended or overlooked in the Board's decision. Experience has shown that many requests for rehearing are nothing more than reargument of appellant's position on appeal. In response, the rule was revised to limit requests to the points of law or fact which appellant feels were overlooked or misapprehended by the Board.

The 2-month period provided by 37 CFR 1.197(b) for filing a request for rehearing can only be extended under the provisions of 37 CFR 1.136(b) or under 37 CFR 1.550(c) if the appeal involves an *ex parte* reexamination proceeding.

All copies of references in the file wrapper should be retained therein.

For extension of time to appeal to the Court of Appeals for the Federal Circuit or commence a civil action under 37 CFR 1.304(a), see MPEP § 1216 and § 1002.02(o).

For requests for reconsideration by the examiner, see MPEP § 1214.04.

1214.04 Examiner Reversed

A complete reversal of the examiner's rejection brings the case up for immediate action by the examiner. If the reversal does not place an application in condition for immediate allowance (e.g., the Board has entered a new ground of rejection under 37 CFR 1.196(b)), the examiner should refer to the situations outlined in MPEP § 1214.06 for appropriate guidance.

The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references. This is particularly so where the application or *ex parte* reexamination proceeding has meanwhile been transferred or assigned to an examiner other than the one who rejected the claims leading to the appeal. The second examiner should give full faith and credit to the prior examiner's search.

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution.

The examiner may request rehearing of the Board decision. Such a request should normally be made within 2 months of the receipt of the Board decision in the TC. The TC Director's secretary should therefore date stamp all Board decisions upon receipt in the TC.

All requests by the examiner to the Board for rehearing of a decision must be approved by the TC Director and must also be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for approval before mailing.

The request should set a period of 1 month for the appellant to file a reply.

If approved, the Office of the Deputy Commissioner for Patent Examination Policy will mail a copy of the request for rehearing to the appellant. After the period set for appellant to file a reply (plus mailing time) has expired, the application file will be forwarded to the Board.

1214.05 Cancellation of Withdrawn Claims

Where an appellant withdraws some of the appealed claims, and the Board reverses the examiner on the remaining appealed claims, the withdrawal is treated as an authorization to cancel the withdrawn claims. It is not necessary to notify the appellant of the cancellation of the withdrawn claims.